

REMARKS

Prior to entry of this amendment, claims 1, 3, 4, 6-11, 13-15 and 18-39 are currently pending in the subject application. By the instant amendment, dependent claims 40-48 are added. Claims 1, 19, 25, 29, 33 and 36 are independent.

Applicants note with appreciation the Examiner's acknowledgement and acceptance of the replacement drawings filed October 8, 2004.

Claims 1, 3, 4, 6-11, 13-15 and 18-48 are presented to the Examiner for further or initial prosecution on the merits.

A. Introduction

In the outstanding Office action, the Examiner rejected claims 1, 3, 4, 6-11, 13-15 and 18-39 under 35 U.S.C. § 112, first paragraph (enablement), and indicated that claims 1, 3, 4, 6-11, 13-15 and 18-39 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, first paragraph.¹

B. Asserted Rejection under 35 U.S.C. § 112, First Paragraph

In the outstanding Office action, the Examiner rejected claims 1, 3, 4, 6-11, 13-15 and 18-39 under 35 U.S.C. § 112, first paragraph, as purportedly not being enabled by the original disclosure. Applicants respectfully traverse this rejection for at least the reasons set forth below.

In the rejection, the Examiner stated:

The order of using both scattered light[s] before using only one scattered light [is] critical or essential to the practice of the invention . . . The specification teaches how to 1) identify a first type of defect using the two scattered polarized lights before 2) identifying a second type of defect based on only one of the scattered lights. The claims are currently written such that the second step can be performed before the first step. Claims must be include the order of using both

¹ The Office action refers to 35 U.S.C. § 112, second paragraph, on page 2, paragraph no. 2. It is believed that this reference should be to 35 U.S.C. § 112, *first* paragraph.

scattered lights before using only one scattered light since the order is critical or essential to the practice of the invention.

Applicants respectfully disagree with the Examiner's characterization of the claimed subject matter, and respectfully submit that all critical and essential features of the claimed methods and apparatuses are recited in the claims. For example, the Examiner has asserted that the claims must include "the order of using both scattered lights before using only one scattered light." However, this characterization is inaccurate. For example, referring to drawing FIG. 4 of the original application, an identification of the defects CL1, CL2 and CL3 may be made based on the P-light coordinates (x-axis coordinate) alone. Identification of defects CL4 may be made based on both the P-light and C-light distributions (x- and y-axis coordinates, respectively). No particular order is required. Moreover, while a particular embodiment described in connection with drawing FIG. 6 of the application includes identifying defects CL4 prior to identifying defects CL1, CL2 and CL3, this is merely a preferred embodiment and, contrary to the Examiner's assertion, the disclosure does not require that the identification of the CL4 defects always occur prior to the identification of the CL1, CL2 and CL3 defects. Thus, no such order need be recited to enable the claims under 35 U.S.C. § 112, first paragraph.

Applicants note that, for the identification of defects to occur, the first and second lights are irradiated onto the object, after which the respective scattered lights are collected. However, this particular order is already affirmatively recited in the claims. Therefore, applicants respectfully submit that the claims, as presently written, recite all the critical and/or essential orders and features of the method. Therefore, applicants respectfully request that this rejection be favorably reconsidered and withdrawn.

C. Allowable Subject Matter

Applicants appreciate the Examiner's indication of allowable subject matter in claims 1, 3, 4, 6-11, 13-15 and 18-39. Applicants respectfully submit that the claims are in condition for allowance, and a notice to that effect is respectfully requested.

D. New Claims

By the instant amendment, new claims 40-48 are added to depend from independent claims 1, 25 and 33, respectively. No new matter is added. Support for claims 40-48 can be found in the application as originally filed. For example, support for determining a distribution of the collected first and second scattered lights, and establishing a transition line, as recited in claims 40, 41, 43, 44, 46 and 47, can be found in paragraphs [0079]-[0081] of the application as originally filed. Support for determining that a defect corresponds to a first region of a distribution of one of the first scattered light and the second scattered light, as recited in claims 42, 45 and 48, can be found in, e.g., paragraph [0088] of the application as originally filed.

Applicants respectfully request entry and examination of claims 40-48, and respectfully submit that these claims are allowable for at least the reasons that their respective base claims are allowable.

E. Conclusion

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.